

Remarks

Claims 20 and 21 are currently pending. Claims 22 and 23 have been withdrawn without prejudice to the content thereof. Applicant reserves the right to prosecute claims directed to their content in subsequently filed related applications.

I. Restriction requirement

Applicant acknowledges that its provisional election of Group VIII in its response dated March 6, 2006 applies to claims 20 and 21 of the currently pending set of claims. Although Applicant maintains its traversal of the restriction requirement, Applicant has amended the pending claims to reflect its provisional election of Group VIII.

II. Rejection of claims 20 and 21 under § 102(b)

Claims 20 and 21 stand rejected as being anticipated by (i) Mechetner et al. (Clin. Cancer Res., Vol. 4, pp. 389-98 (1998)) (hereinafter, “Mechetner *et al.*”); (ii) Jankun et al. (J. Cell. Biochem., Vol 53, pp. 135-44 (1993)) (hereinafter, “Jankun *et al.*”) or U.S. Patent No. 5,679,350 of Jankun et al. (hereinafter, “the ‘350 patent”); and (iii) Gong et al. (Dev. Biol., Vol. 183, pp. 166-82 (1997)) (hereinafter, “Gong *et al.*”).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the...claim.” *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1987). Thus, the anticipating reference must disclose each and every limitation of the claimed invention.

A. Mechetner et al.

Applicant respectfully traverses the rejection of claims 20 and 21 as being anticipated by Mechetner *et al.* Mechetner *et al.* fails to disclose each element of the claimed inventions, and therefore does not qualify as an anticipating reference.

Specifically, Mechetner *et al.* compare gene expression levels only among cancerous cell lines as discussed on page 392, col. 1, lines 23-36 (“We used a series of MCF7 breast carcinoma-derived cell lines as a model of clinical breast cancer for standardization and comparison of Pgp detection methods”). The claims of the instant application compare the gene expression levels in cancerous cells to gene expression levels “in a non-tumor sample or cells comprising said sample” (claim 20, lines 7-9). Mechetner *et al.* disclose no such comparison of gene expression in non-tumor cells. Hence, the claims of the instant application require an element that Mechetner *et al.* fails to disclose. Thus, Mechetner *et al.* cannot anticipate the instant claims.

B. Jankun et al. and the ‘350 patent

Applicant respectfully traverses the rejection of claims 20 and 21 as being anticipated by Jankun *et al.* or the ‘350 patent. These references fail to disclose each element of the claimed inventions, and therefore do not qualify as anticipating references.

The claims of the instant application require the identification of cells and/or tumors that are “resistant to taxane chemotherapeutic drugs.” Jankun *et al.* and the ‘350 patent disclose methods directed toward the identification of cells having higher expression levels of Urokinase plasminogen activator receptor (uPAR), and teach that certain malignant cells show higher levels of uPAR expression. The instant claims are drawn to methods of identifying tumors and tumor cells that are resistant to taxane chemotherapeutic drugs. Neither Jankun *et al.* nor the ‘350 patent purports or suggests the identification of tumors and/or cells that are “resistant to taxane chemotherapeutic drugs.” Consequently, since these references do not teach that levels of uPAR expression have anything to do with resistance to taxane chemotherapeutic drugs, the claims are not anticipated by these references.

C. Gong et al.

Applicant respectfully traverses the rejection of claims 20 and 21 as being anticipated by Gong *et al.* The claims of the instant application require the identification of cells and/or tumors that are “resistant to taxane chemotherapeutic drugs.” Gong *et al.* disclose methods directed toward the identification of cells having higher expression

levels of HIP116, and teach that HIP116 expression is induced in certain tumors cells. As discussed above, the instant claims are drawn to methods of identifying tumors and tumor cells that are resistant to taxane chemotherapeutic drugs. Gong *et al.* neither purports nor suggests the identification of tumors and/or cells that are “resistant to taxane chemotherapeutic drugs.” Therefore, Gong *et al.* cannot anticipate the instant claims.

D. Conclusion

For the reasons stated above, Applicant believes that claims 20 and 21 are novel over the cited references, and respectfully requests the withdrawal the rejections under § 102(b).

CONCLUSION

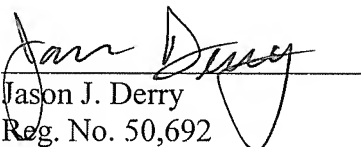
The Applicants invite the Examiner to contact the Applicants’ undersigned representative at (312) 913-0001 if the Examiner believes that this would expedite prosecution of this application.

Applicants believe that no fees are due for this Response. If Applicants are mistaken, please charge any requisite fees to our Deposit Account, No. 13-2490.

Respectfully submitted,
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